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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Sebastian Kraufvelin

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EXAMINER

TORRES, MARCOS L

ART UNIT

PAPER NUMBER

2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,697	Applicant(s) KRAUFVELIN ET AL.	
	Examiner MARCOS L. TORRES	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3-29-05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-9-08, 2-11-08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because figure 2 fails to provide a legend for the items 10, 20, 21, 22, 23, 5, 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim limitations of “an area event notification request” is directed to non-functional material, which is non-statutory.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 22 provides for the use of an area event notification request, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4-6, 9-14, 16 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Murray 6484033.

As to claim 1, Murray discloses a method of providing information regarding a mobile station [60,62,66] adapted for communication via a communication system [10], comprising: receiving an area event notification request at a location service entity provided in association with the communication system [see col. 10, lines 24-30], the area event notification request containing information associated with the identity of the mobile station and an area of interest [see col. 7, lines 53-65]; activating monitoring for an event indicative of a change in the presence status of the mobile station relative to said area of interest; and signaling a notification in response to detection of such event [see col. 10, lines 24-37].

As to claims 4-6, Murray discloses a method wherein the monitoring is based on at least one location/routing/service area determined based on said information of the area of interest [see col. 11, lines 1-43; col. 12, line 56 - col. 13, line 35].

As to claims 9-10, Murray discloses method comprising cancelling the request for area event notifications, after the signaling notification step [col. 2, lines 1-17].

As to claims 11, Murray discloses a method wherein said signaling notification is responsive to detection of said event over a predetermined time period [col. 4, lines 45-59].

As to claims 12, Murray discloses a method wherein successive signaling within a predetermined time period is limited [col. 4, lines 45-59].

As to claims 13, Murray discloses a method according wherein an LCS client defines the predetermined time period such that successive signaling is limited [col. 4, lines 45-59].

As to claims 14, Murray discloses a method wherein a network operator defines the predetermined time period such that successive signaling is limited [col. 4, lines 45-59].

As to claims 16, Murray discloses a method wherein the step of receiving an area event notification request is responsive to a location update [see col. 4, lines 60 – col. 5, line 43].

As to claim 18, Murray discloses a arrangement in a communication system, comprising: mobile stations [60,62,66] adapted for wireless communication with base stations [56] of the communication system [10] [see col. 10, lines 24-30]; a location service entity [76] adapted for receiving an area event notification request containing information associated with the identity of a target mobile station and an area of interest [see col. 7, lines 53-65]; monitoring means for monitoring, in response to receiving said request, for an event indicative of a change in the presence status of the target mobile station relative to said area of interest and for signaling a notification in response to detection of such event [see col. 10, lines 24-37].

As to claim 19, Murray discloses an arrangement wherein the monitoring means are provided in association with the target mobile station [see col. 4, lines 34-45].

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray in view of Wilson 7203502.

As to claim 2, Murray discloses everything as explained above except for a method wherein the monitoring is activated at the mobile station. In an analogous art, Wilson discloses a method wherein the monitoring is activated at the mobile station [see fig. 1b, first step, with item 102]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to combine these teachings to provide location based services to the phone such as locating individuals and coordinating meetings.

11. Claims 3, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray in view of Havinis 6169899.

As to claims 3, 15 and 20, Murray discloses everything as explained above except for method wherein the monitoring is based on the identity of at least one cell of the communication system selected based on said information of the area of interest. Havinis et al further teaches wherein the monitoring is based on the identity of at least one cell of the communication system selected based on said information of the area of interest and area of interest is taken into consideration in cell selection. (Column 5, Lines 46- 50 and Column 2, Lines 42-46). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to combine these teachings to provide location based services to the phone such as locating individuals in a desired area.

12. Claims 7-8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray in view Miriyala 7024195.

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As to claim 8, Murray discloses everything as explained above except for a method wherein the request contains further information regarding the event to reported, the further information defining whether entering or leaving of the area of interest shall be reported. In an analogous art, Miriyala discloses a method wherein the request contains further information regarding the event to reported, the further information defining whether entering the area of interest shall be reported [see col. 3, lines 42-60]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to combine these teachings to send advertisement when entering in certain area.

As to claims 7 and 21, Murray discloses everything as explained above except for, wherein the area of interest is defined by means of the shape thereof. In an analogous art, Miriyala discloses wherein the area of interest is defined by means of the shape [size] [see col. 3, lines 42-60]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to combine these teachings to send advertisement when entering in certain area.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray in view of Nakagawa 5621414.

As to claim 17, Murray discloses everything as explained above except for a method according further comprising the step of confirming the location of the mobile station responsive to the signaling location, to ensure the location corresponds to the area of interest. In an analogous art, Nakagawa discloses confirming the location of the mobile station responsive to the signaling location, to ensure the location corresponds

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to the area of interest [see col. 1, lines 7-18]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to combine these teachings to minimize errors.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS L. TORRES whose telephone number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/Marcos L Torres/
Examiner, Art Unit 2617

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